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Examiner Janell E. Taylor at Fax No.: 1-703-872-9306

On March 15, 2001

TOWNSEND and TOWNSEND and CREW LLP

By:

Leticia A. Cuevas-Hernandez

PATENT
Attorney Docket No.: 018002-001010US

#17
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B 11/22/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Patrick A. Schneider et al.

Application No.: 09/485,193

Filed: June 3, 1999

For: USE OF PROTHYMOSEN IN THE
DIAGNOSIS AND TREATMENT OF
ENDOMETRIOSIS

Examiner: Taylor, Janell E.

Art Unit: 1634

RESPONSE TO RESTRICTION
REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the restriction requirement mailed February 26, 2002,
please enter and consider the following.

REMARKS

Claims 1-56 are pending in the present application. The Examiner has requested that the Applicant elect one group under 37 CFR 1.499 as follows:

- I. Claims 1-32, drawn to a method for use in the diagnosis of endometriosis and in the monitoring of the progress of endometriosis.
- II. Claims 33-35, drawn to kit comprising a compound that binds a prothymosin gene.
- III. Claims 36-41, drawn to a method for use in the diagnosis of endometriosis in a subject comprising detecting prothymosin gene product in vivo.

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IV. Claims 42-43, drawn to a method for the treatment of endometriosis comprising administering to the subject a probe comprising a detectable label.

V. Claims 44-45, drawn to a screening method for determining whether a compound modulates the expression of a prothymosin gene product in an endometrial cell.

VI. Claims 46-56, drawn to a method for treatment of endometriosis in a subject comprising the step of administering to the subject a compound that decreases prothymosin activity.

Applicant provisionally elects to prosecute Group I (Claims 1-32), with traverse.

TRAVERSE

Applicant respectfully requests that the diagnostic claims of Groups I and III be grouped together. Restriction is only proper when search and examination is "a serious burden on the Examiner." See MPEP 803. What is more, the restriction requirement fails to provide a reason or an example to support a conclusion that these claims must be examined separately. The restriction requirement does not show that Groups I and III are subject to separate classification, have separate status in the art, or include different fields of search. Thus, a *prima facie* case of serious burden has not been made under MPEP 803.

Applicant submits there is no undue burden on the Office to consider Groups I and III together. It is natural and desirable to conduct the search in connection with examination of the claims of Groups I and III. In fact, simultaneous prosecution of the Groups would be more efficient.

CONCLUSION

Applicant thus requests that the Office reconsider this restriction requirement, and regroup Groups I and III into a single group.

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If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


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